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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,075	01/18/2004	Frederic Fortin	09955.0047-01000	1916
22852	7590	04/18/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			04/18/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/760,075

**Applicant(s)**

FORTIN ET AL.

**Examiner**

Nicholas Woodall

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 01/18/2004.

#### ***Allowable Subject Matter***

2. The indicated allowability of claim 11 is withdrawn in view of the newly discovered reference(s) to Clayton Jr. Rejections based on the newly cited reference(s) follow.

#### ***Election/Restrictions***

3. Newly submitted claims 21-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus, since the process as claimed does not require the apparatus as claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. The examiner would like to note that this application is a continuation of the PCT application and not a national stage continuation of the PCT application. Therefore, the current application falls under the U.S. restriction guidelines.

**Double Patenting**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 13-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-27 of copending Application No. 10/505469. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 13-20 of the current application and claims 20-27 of the copending application lies in the fact that the current application claims include many more elements and is thus much more specific. Thus the invention of claims 13-20 are in effect a "species" of the "generic" invention of claims 20-27. It has been held that the generic invention is "anticipated" by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Since claims 20-27 are anticipated by claims 13-20 of the current application, they are not patentably distinct from claims 13-20.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Navas (U.S. Patent 5,375,823) in view of Clayton Jr. (U.S. Patent 4,445,674).

Regarding claim 13, Navas discloses a device comprising a cylindrical body portion, a first rod portion, a second rod portion, a first dampening member, and a second dampening member (see Figure 1 below). The cylindrical body includes a first end and a second end. The first rod portion extends from the first end of the cylindrical body in a first direction. The second rod portion includes a first elongated body and an enlarged end portion, wherein the enlarged end portion is positioned within the cylindrical body portion and the first elongated body extends in a second direction opposite the first direction and passes through an opening in the second end of the cylindrical portion. The first dampening member is positioned between the enlarged end portion and the first end of the cylindrical body. The second dampening member is

positioned between the enlarged end portion and the second end of the cylindrical body. Regarding claim 14, Navas discloses a device wherein the second end of the cylindrical body comprises a cap. Regarding claim 15, Navas discloses a device wherein the cap includes a threaded inner region. Regarding claim 17, Navas discloses a device wherein the second dampening member includes a ring shape with an opening capable of receiving the first elongated body of the second rod portion. Regarding claim 18, Navas discloses a device wherein the opening in the second end of the cylindrical body portion includes a width that is less than a width of the enlarged end portion but is greater than a width of the first elongated body capable of allowing the second rod portion to laterally bend with respect to the cylindrical body portion.

Regarding claim 13, Navas discloses the invention as claimed except for the first dampening element and the second dampening element each include at least one inclined face. Clayton Jr. teaches a device comprising a first dampening element and a second dampening element, wherein each of the dampening elements includes at least one inclined face in order to help transfer heat from the device caused by friction (column 4 lines 30-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Navas wherein each of the dampening elements include at least one inclined face in view of Clayton Jr. in order to help transfer heat from the device caused by friction.

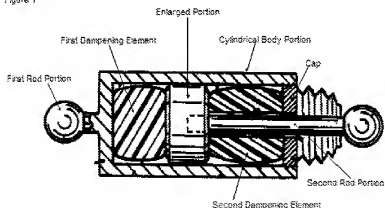
Regarding claim 19, the combination of Navas and Clayton Jr. disclose the invention as claimed except for the opening in the second end of the cylindrical body being eccentrically located on the second end. It would have been obvious to one

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having ordinary skill in the art at the time the invention was made to manufacture the combination of Navas and Clayton Jr. wherein the opening is eccentrically located on the second end of the cylindrical body, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding claim 20, the combination of Navas and Clayton Jr. disclose the invention as claimed except for the opening in the second end of the cylindrical body includes an oblong shape. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to manufacture the combination of Navas and Clayton Jr. wherein the opening in the second end of the cylindrical body includes an oblong shape, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing an opening in the end of a cylindrical body. In re Dailey and Eilers, 149 USPQ 47 (1966).

Figure 1



8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Navas (U.S. Patent 5,375,823) in view of Clayton Jr. (U.S. Patent 4,445,674) further in view of Alby (U.S. Patent 6,241,730).

Regarding claim 16, the combination of Navas and Clayton Jr. disclose the invention as claimed except for the first rod portion including a threaded end capable of engaging a threaded portion of the cylindrical body portion. Alby teaches a device comprising a first rod portion (4a) including a threaded end (15) capable of engaging a threaded portion (13) of a cylindrical body (4) in order to allow the cylindrical body to be connected to various elements having different lengths and/or shapes (column 4 lines 35-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the combination of Navas and Clayton Jr. wherein the first rod portion includes a threaded end capable of engaging a threaded portion of the cylindrical body in view of Alby in order to allow the cylindrical body to be connected to various element having different lengths and/or shapes.

#### ***Response to Arguments***

9. The applicant did not provide any arguments directed to new claims 13-27. The examiner has presented new grounds of rejection as necessitated by the amendment. However, since the applicant mistakenly listed claim 11 as being allowable in the previous office action. The examiner was wrong to do so because the claim was rejected under 35 U.S.C. 112 2<sup>nd</sup> paragraph as being an improper independent claim and therefore could not be determined due to the improper dependency. Since the examiner mistakenly listed claim 11 as being allowable this office action is non-final.



***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references that the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733